UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,080	02/11/2004	Daisuke Sakiyama	018656-682	3417

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EXAMINER
LEE, CHUN KUAN

ART UNIT	PAPER NUMBER
2181	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Advisory Action ***Before the Filing of an Appeal Brief***	10/775,080	SAKIYAMA ET AL.
	Examiner	Art Unit	
	Chun-Kuan (Mike) Lee	2181	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>28 December 2006</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

     Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a)☒ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b)☐ They raise the issue of new matter (see NOTE below);

   (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

     NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: <u>1-16</u>.

   Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>Please see Continuation Sheet below.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.

13. ☐ Other: _____.

DONALD SPARKS
SUPERVISORY PATENT EXAMINER

Applicant's clear intent of furthering prosecution with the amendments made on 12/28/2006 changinh what the claims 1-13 originally encompassed such that the examiner would need to perform a further search. Applicant's arguments regarding claims 14-16 have fully been considered, but are not found to be persuasive.

As per claims 1-13, the independent claims 1 and 8 now require "a first storage destination memory" and "a second storage destination memory", whereas in the previously presented claims, the independent claims did not require the amended limitations.

In responding to applicant's arguments regarding the independent claims 1 and 8 rejected under 35 U.S.C. 103(a) that there is no support for combining Terajima with Utsunomiya because there is no motivation for one ordinary skilled in the art to combine the refereices, as stated on page 10, 1st paragraph to last paragraph. Applicant's arguments have fully been considered, but are not found to be persuasive.
The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as stated in the preceding final office action, it would have been obvious to combine Terajima with Utsunomiya for the benefit of ensuring that the external memory is properly connected before data transferring increasing the data transferring integrity (Terajima, col. 5, ll. 3-9), and further more, also provide the benefit of reducing the cost of the printer as memory is saved (Terajima, col. 1, l. 52 to col. 2, l. 5).

In responding to applicant's arguments regarding the independent claim 14 rejected under 35 U.S.C. 103(a) that the combined teaching of Utsunomiya and Terajima fail to disclose the feature of storing the image data in either the expansion memory or work memory based on the detection of the expansion memory, as stated on page 11, 3rd paragraph. Applicant's arguments have fully been considered, but are not found to be persuasive.

The rejection of independent claim 14 is based on the combination of Utsunomiya, Kizaki and Terajima, not just on Utsunomiya and Terajima. Further more, applicant's argument appears to be referring to the following claimed limitation,

"a controller that, where the print job is a job in which multiple copies of identical images are to be printed, (i) and when said detection unit detects that an expansion memory is mounted, prints out a first copy of the image data processed in said work memory and stores the image data stored in said work memory in said expansion memory and executes printing for a second copy onward via the printer unit using the image data stored in said expansion memory, and (ii) when said detection unit detects that an expansion memory is not mounted, executes printing for the second copy onward via the printer unit using the image data stored in said work memory,"

that the combined references of Utsunomiya, Kizaki and Terajima fail to teach.

As recited from part of the preceding final office action, the examiner relies on the references for the rejection of independent claim 14 as following:

Utsunomiya teaches a printer, comprising
a work memory (RAM 1037 of Fig. 3) that includes a storage area (Fig. 3, ref. 1032, 3007) used for storing image data, as well as a processing area (Fig. 3, ref. 3008, 3009) used for processing (process by converting) image data to raster images for received print jobs (Fig. 3 and col. 5, ll. 40-67);
a mounting unit used for mounting an expansion memory (external memory 1043 of Fig. 2) used for data storage (HD 1043 of Fig. 3), wherein the hard drive is mounted as external memory for storing print data (col. 5, ll. 5-16); and
a controller (printer controller 1031 and memory controller 1044 of Fig. 2) that, where the print job is a job in which multiple copies of identical images are to be printed (e.g. multiple-copy print) (col. 5, ll. 17-32; col. 6, ll. 20-44 and col. 8, ll. 28-40), printing out a fist copy, a second copy and onward of the image data processed in said work memory or from an expansion memory.

Kizaki teaches an image forming apparatus such as a digital copier, a facsimile machine, a printer, and a scanner ([0002]) comprising a data input/output control unit (Fig. 6, ref. 600) implementing multiple copies as a first copy is stored in and output from a primary memory device (semiconductor memory) (Fig. 6, ref. 606) and a second and following copies are stored in and output from the secondary memory device (hard disk drive: HDD) (Fig. 6, ref. 607) ([0117]-[0118]).
By combining Kizaki's printing of the first copy from the primary memory device and the second and following copy from the secondary memory device into Utsunomiya's printer, the resulting combination of the references further teaches the printer comprising the controller that
prints out the first copy from the primary memory device (i.e. semiconductor memory such as the work memory) as the image data is stored in the primary memory device; and
prints out the second and following copies from the secondary memory device (i.e. external memory such as the HDD) as the image data is to be stored in the secondary memory device for the second and following copies.

Terajima teaches a facsimile apparatus with a printing function comprising:
a sensor (Fig. 1, ref. 119) utilized for detecting whether or not a external memory (Fig. 1, ref. 109) is coupled to the control unit (Fig. 1 and col. 3, l. 11 to col. 4, l. 14); and
a controller (Fig. 1, ref. 101) that selects the storing of the received communication data in an internal RAM processing memory (Fig. 1, ref. 115) if the sensor does not detect the presence of the external memory (col. 4, ll. 14-20) and if the external memory is detected to be present, the received communication data is to be stored in the   external memory (col. 3, l. 62 to col. 4, l. 4), and prints the received

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communication data from either the internal RAM processing memory or the external memory, depending where it was stored earlier (col. 4, ll. 47-64).

By combining Terajima's sensor into Utsunomiya and Kizaki's printer, the resulting combination of the references further teaches the printer comprising

the sensor (i.e. detection unit) utilized for detecting whether or not the external memory (i.e. expansion memory) has been mounted to said mounting unit;

the controller that,

when the sensor detect that the external memory is mounted, prints out the first copy from the primary memory device (i.e. semiconductor memory such as the work memory and the internal RAM) as the image data is stored in the primary memory device, and stores the image data in the primary memory device into the secondary memory device for implement the print out of the second and following copies from the secondary memory device (i.e. external memory such as the external HDD); and

when the sensor detects that the external memory is not mounted, prints out the second and following copies utilizing the image data stored in the primary memory.

In responding to all of applicant's arguments, the examiner will maintain his position and rejection of record.

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